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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,769

03/20/2006

Horst Lange

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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/533,769	<b>Applicant(s)</b> LANGE ET AL.	
	<b>Examiner</b> MARC S. ZIMMER	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/31/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

***Claim Rejections - 35 USC § 101/112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The present Examiner has concerns that seem to be consistent with those outlined in International Preliminary Examination Report (IPER) of the corresponding PCT application. That is, although  $V^1$  and  $V^2$  do have some structural limitations attached to them, there is no indication in the claims that  $V^1$  and  $V^2$  are necessarily separated from one another by a unit Q thus making their assignment for the purposes of determining whether or not  $V^2/V^1 < 1:3$  virtually impossible. The problem is exacerbated by the fact that, midway through claim 1, V is said to represent, "at least one group  $V^1$  and at least one group  $V^2$ ."

Considering the claim language in the context of the Specification, and especially the assignments made in the Examples, it is the Examiner's belief that  $V^1$  and  $V^2$  are not to be bonded to one another but, of course, the claims do not currently mandate this. Nevertheless, for the purpose of evaluating the claimed invention against the prior art, and in anticipation of Applicant's reply to this Office action including amendments that clarify this matter, the claims will be treated as though  $V^1$  and  $V^2$  are necessarily separated by Q.

Claims 11 and 12 provide for the use of a copolymer, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 11 and 12 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang et al., U.S. Patent # 6,818,610.

It is acknowledged that this reference does not expressly disclose a polymer adhering to the  $V^2/V^1$  ratio, the closest embodiment being that outlined in Example 3 wherein said ratio is precisely 1:3. Nevertheless, the Examiner believes that the claimed invention is at least obvious insofar as (i) no criticality for this limitation is

Art Unit: 1796

demonstrated by Applicant's Specification, (ii) the lack of any limits on the relative molar quantities of the epoxy-functional monomer, amine-functional monomer, and haloalkyl-functional monomers stipulated by the prior art, (iii) the finding in *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) which states that, "a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected [the claimed product and a product disclosed in the prior art] to have the same properties."

As an aside, there is nothing prohibiting an -O- group and a -C(=O)- group from being adjacent to one another in V<sup>1</sup> and V<sup>2</sup>.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 7-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/533,837.

There is substantial overlap between the inventions where the moiety Q of the copending claims comprises an ammonium-containing residue. One distinction between them is that the co-pending claims stipulate that the radicals  $V^1$  are devoid of ester groups. However, the instant claims, insofar as they are silent as to the presence/absence of ester groups, embrace both those permutations wherein an ester group is present, and those where it is absent, it is the Examiner's opinion. The other distinction between the claims is in the molar relationship between  $V^1$  and  $V^2$ . The instant claims stipulate that  $V^2/V^1$  is  $< 1:3$  whereas the copending claims require only that they are not present in equimolar quantities. While it is appreciated the range of all  $V^2/V^1$  values disclosed in the co-pending claims fully encompasses the range recited by the present claims, the present range is not such a small fraction of the larger range so as to necessitate a rationale as to what would have motivated the selection of only those polymers having  $V^2/V^1$  is  $< 1:3$ .

A quick perusal of the dependent claims verifies that they mirror each other in the manner in which they limit the independent claim, claim 1.

This is a provisional obviousness-type double patenting rejection.

The ISA has cited several documents as being especially germane to the claims on the basis that the assignment of  $V^1$  and  $V^2$  is arbitrary since there is nothing

Art Unit: 1796

stipulating that they be separated by a group Q. Although the Examiner tends to agree with that position, Applicant is being given an opportunity to respond to this matter before any additional consideration is given to rejecting the claims over one or more of the references summarized in the IPER.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 2, 2008

/Marc S. Zimmer/

Primary Examiner, Art Unit 1796

Application/Control Number: 10/533,769  
Art Unit: 1796

Page 7